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| 09/985,734      | 11/06/2001  | Catherine A. Haala   | US 1295/01          | 4237             |

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EXAMINER

BAUM, RONALD

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2131

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/985,734

Applicant(s)

HAALA, CATHERINE A.

Examiner

Ronald Baum

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The new title should indicate that the invention concerns identification cards and identity verification. The following title is suggested: National identification card system and biometric identity verification method for negotiating transactions.
2. The abstract of the disclosure is objected to because it is not fully descriptive of the claimed invention. The abstract does not mention specifically that biometric characteristics are used as means for identity verification in conjunction with negotiating a transaction. Correction is required. See MPEP § 608.01(b).
3. The use of the trademarks Visa, Master Card, Discover, and American Express has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

4. The disclosure is objected to because of the following informalities: "anther" constitutes a spelling error in section [0003]. Appropriate correction is required. This example is illustrative only and the applicant is requested to correct any other similar informalities.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

One skilled in the art would not be able to make or use the invention with respect to the profile and profile information referred to in independent claims 1, 14, 17, and in dependent claims 7, 9,10 and in 2-6,8,11-13,15-16, and 18-20 by virtue of their respective dependencies. The use of profile information, through storage, collection and modification is found in the claims. This profile information may comprise various fields of information and may be modified to include data from transactions. It is unknown if all the various stored profile information is to be collected from the person attempting the transaction or simply a subset of this information. Though a system unit is disclosed for collection of biometric data, a unit for collection and modification of profile data is not disclosed. One skilled in the art would not be able to determine how a system unit is to collect, store, and modify profile information in

conjunction with the methods for obstructing a transaction, without undue experimentation, since details of such systems were not disclosed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1- 4, 11, 12, 14-15, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Pilot smartcard to roll out next year”, Computimes Malaysia (8 October 1998) in view of Polansky, U.S. Pre Grant Publication No. 2001/0045458, and further in view of Hendry, Mike, Smart Card Security and Applications, Artech House, Inc., 1997.

7. As per claim 1, Computimes Malaysia of 8 October 1998 (hereafter Malaysia) discloses the Malaysian multi purpose smart card including applications as national identity card, driving license, medical and immigration card. The card has a memory to store photo and thumbprints for biometric uses as well as application data or data for future applications.

Though the reference discloses the use of biometrics it does not disclose the specific details for implementing the smart card as part of the invention of claim 1.

Polansky discloses an identification card verification system with an associated method for authorization of a user during a transaction. The population relevant to processing of a transaction is those desiring the services provided by the card. [0006] discloses that each card

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has information stored relating to the user, constituting a profile, where a profile is defined as some field or fields of information relating to the card user. [0006] also states that an identifying biometric characteristic of an authorized user is stored in each card, in the form of a fingerprint. During the verifying step, the profile information as well as the biometric characteristic stored on the card is compared with a central database (see [0012]). The fingerprint is also obtained directly from the cardholder ([0010-0011]) and compared with the pre-stored fingerprint in the database (see [0012]). The transaction is obstructed if either comparison is unsuccessful. Hence, Polansky's teachings conform to steps a-h) and j) of claim 1 of applicant's invention. In the event that either comparison is unsuccessful, the fingerprint given by the user attempting verification may be stored and compared to other databases to facilitate apprehension [0036].

Malaysia discloses the use of a smartcard in a national ID system including immigration and drivers license applications (Abstract). Polansky smart card and biometric system discloses using the smartcard of the invention for immigration applications in [0025]. As Malaysia doesn't disclose details needed to implement a smartcard based immigration application, and the smartcard immigration application of Polansky discloses such an implementation, the examiner asserts that, motivation exists for Polansky smart card and biometric system to be used as part of the multi-purpose smart card of Malaysia's immigration application system.

The multi-purpose smart card of the Malaysia and Polansky smart card combination fails to teach the use of determining an active or inactive status of the smart card (i.e., data device).

Hendry teaches of blocking and unblocking smartcards in lost, stolen, and misused card scenarios (pages 137- 139). When a card is determined to be stolen, misused, etc., the terminal or host computer can set flags that block the card per se, or an application associated with the card.

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The card can later be reset, or made unblocked and active again based on some specific criteria (page 139, Block and Unblock paragraph). This corresponds to the invention of claim 1 data device being determined to be in an inactive and active status state.

The examiner asserts that it would have been obvious for one of ordinary skill in the art to make use of blocking feature of Hendry to make the smart card of the combination inactive if misuse were detected. Such misuse in the environment of immigration is illegal immigration using counterfeit identification. This misuse of the immigration system is well known and the examiner takes official notice of such. The examiner asserts one skilled in the art would have been motivated to block use of a counterfeit multipurpose card in other applications (i.e., drivers license and medical to prevent additional fraud. Hendry provides the obvious way to do so in the Malaysia-Polansky combination.

As per notification of authority, the examiner asserts that it would have been obvious to notify law enforcement authorities involved in use of drivers license (e.g., a police officer) and immigration (e.g., INS official) if an invalid card were being used or if the comparisons set forth in Polansky fails. In fact, Polansky discloses rejection of the card, see Fig. 1. The examiner asserts that it would have been obvious to let an official using the Polansky system knows that the card is rejected.

Alternately, the examiner argues that rejection of the card is notification that at least the comparisons in the combination failed.

Finally profile information is disclosed in Figure 5 of Polansky.

Thus claim 1 is rejected in view of the Malaysia-Polansky-Hendry combination.

8. Referring to Claim 2, it is clear that verification of an authorized identity is required to negotiate a transaction in Polansky's invention. In the environment of Malaysian national identification system, the card would serve as identification for driver's license, immigration and medical environments. If the card were invalid due, for example to counterfeit, the examiner asserts that blocking the card would block its use in any subsequent application as the entire card is blocked, see page 139 of Hendry.

9. Referring to Claim 3, Law enforcement as the authority has been addressed above.

10. Referring to Claim 4, Polansky discloses various environments in which his ID card could be used such as E-commerce, credit center, and direct online business transactions. The examiner asserts that such an environment suggests the use of dollar values in the transactions. If credit is involved, the examiner respectfully asserts that the amount of the transaction would depend on what was being purchased. The cost could obviously be any amount including \$100 or more.

11. Referring to Claim 11-12, examiner asserts that it is common knowledge that cards such as driving license and immigration are invalidated following either lapse of predetermined period (i.e., expiration) or an event such as a driving violation, criminal act, expiration of a VISA, and others. The examiner takes official notice that immigration cards, driver's licenses, and medical identification cards expire after predetermined periods. Motivation to make use of expiration in the Malaysia combination would have been for the same reason non-electronic versions of these cards are allowed to expire by authorities involved.

12. Claim 14 differs from claim 1 only in that the particular transaction is subsequent to an obstructed transaction. Multi-purpose smart card implemented using biometric system of



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Polansky as applied in the rejection of claim 1 would not alter the steps. Hendry discloses that the entire card or an application on the card can be blocked, see page 139. The examiner again notes that the smartcard of the Malaysia-Polansky-Hendry combination is multi-application. The different applications noted range from ATM, credit card, e-commerce, POS, medical, immigration and driver's licenses. Thus different criteria for authentication could exist for each application as the entities behind the application would be different. The examiner asserts that it would have been obvious that blocking one application would not necessarily result in blocking of others (e.g., blocking of the POS application does not mean that the user should be prohibited from using the ATM). Hendry provides the suggestion for blocking by application. If blocking by application were implemented, the examiner asserts that each in order to use a subsequent application, the user would still have to be authenticated via comparisons of biometrics and profile information centrally stored, on the card, and obtained from his or her person.

13. As per claims 15, 16 the examiner asserts the given teaching by Malaysia of a multi application card and the disclosure in Polansky of other environments on which the identity card could be used, it would be obvious to add these other applications to the multi application card of Malaysia. Some applications disclosed by Polansky include ATM, POS and E-commerce [0025]. The examiner takes official notice that in an ATM environment, funds are presented for choice in pre-determined increments (i.e., 20, 40, 60). If the amount of funds available are inadequate for a first amount selected from the menu, the transaction would be obstructed and if a second amount requested during a subsequent visit to the ATM were more than the total amount of funds requested, this transaction would likewise be obstructed.

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14. As per claim 17, the above-discussed combination clearly discloses use of a multiple application national identification card for the Malaysian population. The examiner asserts that the system using the national identification card is a national security system as it protects the citizens from fraudulent acts relating to immigration, driving, medical, ATM use, POS use, e-commerce, etc. This card make use of pre-stored profile and identifying biometric characteristics which are compared stored on the card, stored centrally, and obtained from the card carrier. The information from the card, central location and from the person are all compared and used for authentication. Further, the combination suggests determining the activation status of the card, communicating the status to a predetermined authority, and preventing the transaction if the card is blocked or inactive.

Polansky discloses use of a card reader, see Figure 4. Polansky suggests a communication link between central database 44 and card reader 30. Figure 4 discloses comparisons units 64-70 as part of card reader 30.

15. Claims 5- 10, 13, 18- 20 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Computimes Malaysia (8 October 1998) in view of Polansky and Hendry, as applied to claim 4 above, and further in view of Drexler et al. U.S. Patent No. 5,457,747.

Computimes discloses storage of fingerprint. Polansky discloses the use of biometric scanning device including fingerprint sensor 34. Polansky fails to disclose the use of retinal, voice or handprint as an identifying biometric characteristic. .

Drexler et al. disclose a card verification system that may use fingerprint, retinal, voice or handprint as the biometric characteristics for identification. See claims 14-18.

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It would be obvious to include retinal, voice, or handprint as a type of biometric characteristic for identification in the combination of references since Drexler's invention demonstrates that any of those characteristics are suitable in a card verification system.

16. As per claim 6, Polansky discloses use of a magnetic codable card. [0007].

17. As per claim 7, use of name as profile information has been addressed above in the rejection of claim 1.

18. As per claim 8, the examiner asserts that given the teaching in the Malaysian-Polansky-Hendry combination of an identification card with multiple applications including immigration, medical driving license, etc., the person of ordinary skill in the art would have been motivated to use the national identification card for any transaction requiring identification. The examiner takes Official Notice that the various applications in claim 8 all require some form of identification. Thus it would have been obvious to make use these applications using the smartcard of the above combination.

19. As per claim 9, two of the applications identified in the above combination are POS and e-commerce transactions. The examiner asserts that it is well known in either type of transaction to retain information relating to the amount and identification of the parties involved in the transaction and take Official Notice of such. Motivation to store such information in the multiple application identification card would have been to maintain transaction logs of the user. Further, the examiner asserts that if multiple applications exist on the card, it would have been obvious to indicate to which category or application the transaction belongs.

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20. As per claim 10, Hendry discloses the existence of a transaction log, for a smartcard, see p. 137-139. The examiner respectfully asserts that attempts to use a smartcard constitute a "transaction" in terms of Hendry. Thus any attempt to make use of the multiple application card would result in update of the transaction log associated with that card. Motivation to use this feature would have been to keep authorities informed of invalid or fraudulent cards or of fraudulent use of valid cards.

21. Referring to Claim 13, the database accessed by Polansky may be in a remote location, accessed by wired, wireless, or Internet communication. Polansky notes in [0039] that his invention may connect to Internet ATM backbone (wired) or Cell Relay (wireless).

22. Claims 18, 19 correspond to claims 13, 5 respectfully, and are rejected on the same basis.

23. Claim 20 corresponds to claim 4, and is rejected on the same basis.

### ***Conclusion***

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Hickie, UK Patent Application GB 2 151 987 A

2. McGookin, Steve. (5 November 1998). Taking democracy into the digital age:

Fingerprints, photographs and signatures are all you need to vote with your electors' smart card.

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25. Any inquiry concerning this communication or earlier communications from examiner should be directed to Ronald Baum, whose telephone number is (703) 305-4276. The examiner can normally be reached Monday through Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached at (703) 305-9711. The Fax numbers for the organization where this application is assigned are:

After-final (703) 746-7238

Official (703) 746-7239

Non-Official/Draft (703) 746-7246

Ronald Baum

Patent Examiner



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